

REMARKS

Reconsideration of the subject application is respectfully requested in light of the comments which follow. Claims 1-3, 5, 7-20 and 25-38 are pending.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

Claims 1-3, 5, 7-20 and 25-38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,763,643 to Martensson (hereinafter "*Martensson*") on the grounds set forth on pages 2-5 of the Official Action. For at least the reasons noted below, this rejection should be withdrawn.

Claims 1-3, 5, 7-20, 26, and 33-34:

The present claims are directed to floorboards which can be joined mechanically in different patterns so as to resemble traditional parquet flooring comprising blocks. In the prior art floorboards, floorboard pieces were made large with patterning (either laminate or other types) on the surface to simulate multiple small floorboards on a single physical floorboard. The floorboards were traditionally made large so as to minimize waste from cutting edges and simplifying installation time. However, as noted at page 9 of the application and FIG. 1c, floorboard pieces made with large patterning can produce an unnatural appearance by, for example, lateral offset at joints.

The floorboards of claims 1-3, 5, 7-20, 26, and 33-34 address these and other improvements by providing a laminate floorboard of certain maximum dimensions. For example, in independent claim 1, a long edge of the floorboard has a length not

exceeding 80 cm. and a short edge of the floorboard has a length not exceeding 10 cm.

The Official Action relies upon the disclosure in *Martensson* and states on page 2 of the Official Action that *Martensson* discloses the basic claim structure of the instant application but does not disclose the specific long and short edge dimensions. The Examiner then asserts that the Applicant fails to show criticality for the specifically claimed dimensions, therefore it would have been an obvious design choice to use the dimensions such as specified in these claims.

Applicant has previously submitted two declarations from individuals skilled in the relevant art, which declarations demonstrate criticality of the dimensions. However, the Examiner also states that the range given in the claims is too wide to claim a criticality for the success of the invention, noting that the ranges are from 10 cm wide and up to 80 cm long. However, the Examiner provides no legal authority or support for that statement.

This is not a proper standard. It is an applicant's right that he "may set the metes and bounds of that which is sought to be patented." *Andrew Crop. Gabriel Electronics*, 6 USPQ2d 2010, 2014 (Fed. Cir. 1988). Here, applicant has set out a claimed range, e.g., for board size. And, the nonobviousness of the claimed range may be demonstrated by showing the criticality of that range (i.e., unexpected results). See *In re Geisler*, 43 USPQ2d 1362 (Fed. Cir. 1997). To show this criticality, the "evidence of nonobviousness [criticality] must be commensurate in scope with the claims which the evidence is offered to support." *In re Clemens*, 206 USPQ 289, 296 (CCPA 1980). Applicants have met this burden with the declarations of record which clearly demonstrate the criticality of the claimed ranges.

There is no further requirement regarding the claimed range or the size of the claimed range. The Examiner's assertion that the range given in the claims is "too wide" to claim a criticality for the success of the invention is not properly based in the law. It is improper to focus on the "width" or size of the range. Instead, the focus should be on applicant's evidence of nonobviousness (the declarations of record) which clearly demonstrate the criticality of the claimed ranges.

In the event that the Examiner maintains the rejection, the Examiner is respectfully requested to provide some authority for refusing to consider criticality because the claimed range is allegedly too large.

Furthermore, the Examiner has not provided any explanation at all as to why the ranges are allegedly too wide.

Although discussed in detail in prior submissions, as well as in the specification and in the declarations, the state of mind prior to the present invention will be explained in detail hereinbelow. In the prior art, laminate boards were made of a relatively large size for at least three reasons:

- (1) in order to reduce the saw cuts as much as possible (page 6, lines 26-27),
- (2) it was thought that the a floor of larger boards could be installed faster than a floor of smaller boards (page 7, lines 16-17), and
- (3) a floor comprising large sized panels with few joints has a considerable cost advantage over a floor with many smaller sized panels (page 7, lines 2-4).

However, with the large-sized patterned boards, there were problems that the printed patterns that simulate small blocks did not line up when the large boards were installed.

As a result of the development leading to the present invention, it has been surprisingly found that, in spite of the well-known advantages of the larger boards, there are actually many, previously unappreciated advantages of using a larger number of smaller boards. For example:

(1) the claimed small floorboards “provide an improved imitation of a classically patterned parquet flooring, since the joints will be consistent with the parquet blocks and not exhibit any pattern offsets or ‘additional joints’.” See, page 15, lines 15-18 of the present application.

(2) the inventor has also discovered the surprising result that “flooring which comprises small floorboards can be installed almost as quickly and with the same quality as traditional flooring comprising considerably larger floorboards.” See, page 10, lines 21-26 of the present application.

(3) it has further been discovered that the small boards are easier to handle than the larger boards (page 11, line 1),

(4) because the sides are shorter in the smaller boards, there is less friction when sliding two adjacent connecting boards (page 11, line 2),

(5) since the actual connecting elements are proportionately smaller with the smaller boards, there is less material to bend when making a connection so that connecting two adjacent boards together is also easier (page 11, lines 3-5).

Thus, in spite of the industry accepted practice of using as large a board as possible, the inventor determined that the numerous, and previously unrecognized advantages of using smaller boards, can in many instances outweigh the advantages of using larger boards. Other advantages, not specifically set out in the present specification include the facts that:

(6) small boards are easier to install near walls than large boards,

(7) small boards are less inclined to warp in humid environments than the larger boards, and

(8) small boards have more joints per unit area and thus release tension easier due to expansion or shrinking easier than large boards.

The declaration previously submitted by Mr. Gerhard Schultze, a retired employee of Pergo Corporation, who has been involved with laminate flooring from its beginning, supports the foregoing assertions that the smaller boards produce unexpected results, and were contrary to the established thinking of the industry.

Mr. Schultze confirms that prior to the present invention, no one in the industry ever thought of producing floorboards of small size because of the perceived higher production costs and material waste. On the contrary, the general idea was to produce as large floorboards as logistics allowed. The laminate boards were produced in the same presses as the boards for parquet floorboards of wood (engineered wood). The presses produced boards of the size 8 x 4 feet and the laminate boards were sawn into floorboards of the size 1200 x 200 mm to enable stacking on a standard pallet. The 200 mm width of the floorboards is derived from the conventional width of three strips of floorboards. Mr. Schultze also confirms the benefits set forth above, and that the general thinking in the industry was that small boards would be more time consuming to install because no one appreciated the foregoing advantages.

Also of interest is the previously submitted declaration from Mr. Svante Bernow, who has conducted installation tests comparing the installation of the claimed small boards (8.4 cm X 7.56 cm) to the installation of standard size boards

(20 cm X 120 cm). According to Mr. Bernow's tests, a 100 cm X 360 cm area could be installed in 3 minutes and 13 seconds using the small boards while the same area was installed in 3 minutes and 57 seconds using standard boards with an angle-snap installation, and in 5 minutes and 54 seconds using standard boards with a snap-snap installation. Accordingly, the aforementioned advantages of using a small board actually result in shortened installation time.

Accordingly, it is respectfully asserted, based on at least the above, that criticality for the specifically claimed dimensions has been established, thereby rebutting the Examiner's finding of obviousness. For at least this reason, withdrawal of the rejections of claims 1-3, 5, 7-20, 26, and 33-34 is respectfully requested.

It is important to note that none of the advantageous set forth above are in any way diminished by the size of the claimed range. In the event that the Examiner maintains the rejection, the Examiner is also respectfully requested to explain why the above-described criticality would not apply to the claimed ranges.

Furthermore, the Examiner concedes that *Martensson* does not teach the claimed dimensions. Accordingly, the Examiner must modify the reference to arrive at the claims. However, the Examiner appears to be relying on the fact that *Martensson* could possibly be modified. However, the case law is well settled that it is insufficient that the prior art could be modified. The law requires that there is some teaching or suggestion to modify the reference.

"Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, '[t]he mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.'"

In re Laskowski, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989). See also *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In the present case, there is absolutely no suggestion in the prior art to make the *Martensson* boards of the claimed dimensions. In fact, as clearly demonstrated in the response filed on February 16, 2006, there was ample evidence teaching away from making the *Martensson* boards of the claimed dimensions. See the declarations submitted on February 16, 2006 in this case.

Furthermore, it appears that the Examiner's assertion that "it would have been an obvious design choice to use the dimensions such as specified in these claims" (See Page 2 of Office Action dated July 7, 2006), is premised on an impermissible "obvious to try" standard. There is no suggestion or motivation in U.S. Patent No. 6,763,643 ("*Mårtensson*") to use floorboard comprising opposing long edges having a length not exceeding 80 cm and opposing short edges having a length not exceeding 10 cm, as recited in claim 1.

"[O]bvious to try is not the standard of 35 U.S.C. § 103." *In re Antonie*, 195 USPQ 6, 8 (CCPA 1977) (emphasis omitted). An invention is "obvious to try" "where the prior art [gives] either no indication of which parameters [are] critical or no direction as to which of many possible choices is likely to be successful." *In re O'Farrell*, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988). The mandate of 35 U.S.C. § 103 is that the invention as a whole, which embraces the structure, its properties, and the problem it solves, must be considered in obviousness determinations. *In re Wright*, 6 USPQ2d 1959, 1961 (Fed. Cir. 1988).

In view of the foregoing legal holdings, the conclusions in the Official Action are respectfully traversed. Applicant has provided in the specification of the present

application, and in the declarations submitted on February 16, 2006, evidence of criticality to the claimed dimensions, and that such benefits were surprising and unexpected. As set forth in a prior response, the fact that boards slightly larger than the claimed dimensions may have similar benefits is of no consequence.

Claims 25, 26, and 35:

Claims 25 and 26 define a method for making a floor of mechanically locked rectangular laminated floorboards joined in parallel rows that includes placing a second floorboard in a second row at an angle to a first floorboard in a first row and contacting the same, by an upper joint edge, with a joint edge of the first floorboard, locking a new floorboard in the second row to a short side of the second floorboard in the second row, so that the upper joint edge of the new floorboard contacts the joint edge of the first floorboard, laterally displacing both the new and the second floorboard parallel with respect to the long side of the first floorboard, the lateral displacement being longer than the length of the floorboards, and angling down the second and the new floorboard after lateral displacement.

This claimed method is illustrated in Figures 6 and 7 and page 22, line 8 through page 23, line 16, of the present application. However, the present invention is not limited to the illustrated embodiments. These claims were rejected over Martensson.

The Examiner alleges that Martensson suggests the claimed method. However, in the current rejection, the Examiner merely indicates that Martensson teaches floorboards capable of inward angling, and wherein the boards may be

assembled long side to short side and short side to short side. The Examiner did not address any of the other features of the claims.

In the “Response to Arguments” section, the Examiner further explained that the claim language is functional, “with the prior art as being capable of use in such a manner”. With regard to the functional language comment, Applicant submits that the claims are method claims and therefore functional language is appropriate and must be considered. In addition, the mere fact that the prior art boards are capable of performing such functions is completely irrelevant absent some teaching or suggestion to actually teach the claimed functions. The Examiner has not provided any explanation as to how Martensson teaches or suggests the method of claims 25 – 26.

Furthermore, in a prior response, Applicant pointed out that the Examiner did not address, among other items, the feature underlined above, i.e., laterally displacing both the new and the second floorboard parallel with respect to the long side of the first floorboard and the lateral displacement is longer than the length of the floorboards. As set forth in the present specification, the claimed method provides the advantage that an entire row (such as row R2) can be laid without a floor layer having to move along the rows, and to automate laying. See page 23, lines 9-10 and 19-22.

In view of the above identified deficiencies of Martensson, applicant submits that the rejection of claims 25 and 26 is improper and should be withdrawn. Furthermore, this rejection (of claim 25) is substantially the same as made in the prior Office Action. The rejection was traversed for reasons similar to those set forth above. However, the Examiner has failed to address the issues raised by the

Applicant. According to MPEP § 707.07(f), the Examiner must address all traversed material. Accordingly, the outstanding Office Action is improper for failing to address the foregoing issues regarding claim 25.

Claim 27 defines a method for installing a flooring comprising a first and a second type of rectangular floorboards, each floorboard being provided, along opposing long edges and along opposing short edges, with integrated connectors for locking together the floorboard with a similar floorboard, whereby the long edges have a length which is an even multiple of a length of the short edges, and the first type of floorboard, as compared with the second type of floorboard, is mirror-inverted with regard to the connectors. The first and the second types of floorboard are also joinable to each other long side against short side, short side against short side and long side against long side. The method includes joining by inwards angling, two respective, essentially identical short edges of two floorboards of the first type with a long edge of a floorboard of the second type. An embodiment of this invention is illustrated in Fig. 10, and described at page 26, lines 12-15 and 25-27, and page 27, lines 8-25. The resulting patterns can be seen in Figs. 12-16.

The rejection of claim 27 fails to mention several of the features of claim 27. Specifically, there is no discussion of:

(1) where the long edges have a length which is an even multiple of a length of the short edges; and

(2) the first type of floorboard, as compared with the second type of floorboard, is mirror-inverted with regard to the connectors.

Although the rejection alleges that Martensson shows inward angling in Fig. 8, it is clear that the Fig. 8 embodiment is not capable of inward angling.

Accordingly, Martensson fails to teach or suggest several important features of claim 27. Claims 28 and 36 depend from claim 27, and are thus also patentable over Martensson.

As with claim 25, this rejection (of claim 27) is substantially the same as made in the prior Office Action. The rejection was traversed for reasons similar to those set forth above. However, the Examiner has failed to address the issues raised by the Applicant. According to MPEP § 707.07(f), the Examiner must address all traversed material. Accordingly, the outstanding Office Action is improper for failing to address the foregoing issues regarding claim 27.

Claims 29 and 32, are similar to claim 27, although they define systems rather than a method. However, the floorboards of claims 29 and 32 also include the following features:

(1) the long edges have a length which is an even multiple of a length of the short edges; and

(2) the first type of floorboard, as compared with the second type of floorboard, is mirror-inverted with regard to the connectors.

Accordingly, claims 29 and 32, and dependent claims 30, 31, and 37-38 are also patentable over Martensson. As with claim 25, this rejection (of claims 29 and 32) is substantially the same as made in the prior Office Action. The rejection was traversed on February 16, 2006 for reasons similar to those set forth above.

However, the Examiner has failed to address the issues raised by the Applicant. According to MPEP § 707.07(f), the Examiner must address all traversed material. Accordingly, the outstanding Office Action is improper for failing to address the foregoing issues regarding claims 29 and 32.

RELATED CASE

In accordance with rule 56, the Examiner is advised that the assignee of the present application filed a patent application on December 8, 2006 as Serial Number 11/635,674. On page 8 of that application, it is stated:

It is also obvious that all embodiments could be used to provide a floor where the floor panels are made of a single floor element. Practical testing shows however that a floor panel comprising five floor elements could be installed in advanced or complex patterns, e.g., different sizes of floor elements, more than five times faster than if the floor was installed with floor panels comprising only one floor element.

The foregoing paragraph compares installing a floor panel of a complex pattern comprising five elements to installing the five elements individually. As seen in Figure 9 of Serial No. 11/635,674, if floors of a complex pattern are being laid, it may be faster to use a single floor panel comprising five elements than to install the five elements separately. However, this statement is limited to floors with complex patterns.

CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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By: /WCRowland/
William C. Rowland
Registration No. 30,888

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620